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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,615

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Simon G Thompson

36-1951

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12/24/2008

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EXAMINER

SKINNER, SHEWANA D

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/560,615	<b>Applicant(s)</b> THOMPSON ET AL.	
	<b>Examiner</b> SHEWANA SKINNER	<b>Art Unit</b> 4154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This communication is a First Action Non-Final on the merits. **Claims 1-7**, as originally filed, are currently pending and have been considered below.

#### ***Claim Objections***

1. **Claims 2, 3, 5 and 6** are objected to because of the following informalities: The claims do not end in a period and each claim must begin with a capital letter and end with a period per MPEP 608.01(m). Appropriate correction is required.
2. **Claim 4** is objected to because of the following informalities: A properly written independent claim requires a preamble, transition language (i.e. comprising, consisting) followed by the body of the claim this allows for the proper understanding of the claimed invention Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-3** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "agent means" lacks clear and precise definition within the specification. The language of the claim, considered as a whole in light of the specification and given its broadest interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation therefore rendering it indefinite.

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4. **Claims 1 and 4** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 1 and 4 the word "agent" precedes the word "means" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). It is necessary for the words, which precede means to convey a function to be performed. For example, the phrase latch means is definite because the word latch conveys the function latching. In general, if the phrase can be restated as means for and it still makes sense, it is definite. In the above example, latch means can be restated as means for latching. This is clearly definite. However, if means is restated as means for agenting, the phrase makes no sense because the word agent has no functional connotation, and the phrase is indefinite.

5. **Claim 7** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "program or suite of programs" is indefinite. The language of the claim, considered as a whole in light of the specification and given its broadest interpretation is such that a person of ordinary skill in the art would read it with more than one reasonable interpretation and would not be able to discern the metes and bounds of the claim, therefore rendering it indefinite.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-3** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. An “apparatus” defined merely by software or terms synonymous with software is not deemed statutory. The apparatus as recited does not have any structural definition within the claims and the specification does not disclose any structure relationship to said apparatus. Without the structure, the apparatus does not fit within the four statutory classes of method, apparatus, an article of manufacture and composition of matter.
7. **Claims 1 and 4** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The phrase “agent means” as interpreted in the claims, in light of the lack of definition provided in the specification, can be reasoned to be human beings performing the steps within the process and whereby humans are do not fit into the four statutory classes of method, apparatus, an article of manufacture and composition of matter.
8. **Claims 4-6** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 4-6 recite a process for performing negotiations. This process is not deemed statutory unless it is; 1) tied a particular machine or, 2) transforms underlying subject matter (such as an article or materials) to a different state or thing. If neither of

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these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

The claims, as disclosed recite, “a method for performing negotiations using a plurality of computer-based agent means” where “agent means” is reasoned to be software per se, functional descriptive material, not clearly on any medium. There is also no transformation presented within the subject matter. Therefore, these claims do not qualify as a statutory process.

1. **Claim 7** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A “computer program or suite of computer programs” is software per se, not clearly on any medium where “for use with one or more computers” is intended use language holding no statutory weight. Therefore, it does not fit into the four statutory classes of method, apparatus, an article of manufacture and composition of matter.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-7** are rejected under 35 U.S.C. 102(b) as being anticipated by *Ausubel* (5,905,975) hereinafter “*Ausubel*”.

**Referring to Claims 1, 2, 4, and 5:**

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*Ausubel* discloses an apparatus and method for supporting an auction system (*Fig 2*), where an auction is a type of negotiation, that provides the means for initiating interactions within the system (*Fig 2*), means for defining a plurality of negotiating phases (*Fig 3A*) where responses to phases can constrain (modify, delete information relevant to bid) the responses to subsequent phases (*Fig 3B and 3C and sect 3 lines 51-59*) to provide for a dynamically negotiated agreement in accordance with said phase (*Fig 3C*) where the overall negotiating possibilities can be constrained relative to the prior decisions (*Figs 3c and 8 and sec 1 lines 67 through sec 2 line 2*).

**Referring to Claims 3 and 6:**

*Ausubel* discloses an auction system with the means for and the method of; using messages to detail what type of auction (*sect 2 lines 33-37*); using bidding rules to specify the interactions required in said auction (*sect 2 lines 39-50*) and; retrieving the processes from the system (*sect 2 lines 30-32*).

**Referring to Claim 7:**

*Ausubel* discloses a computer implemented system and method of executing the auction (*Abstract*).

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Preist et al (US 2002/0120588)* which discloses a computer system for allowing negotiation between a plurality of entities. *Conklin et al. (6,141,653)* which discloses a multivariate negotiations engine for iterative bargaining.

***Contact Information***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWANA SKINNER whose telephone number is (571)270-7141. The examiner can normally be reached on Monday-Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached at 571-272-6805. The fax number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHEWANA SKINNER/  
Examiner, Art Unit 3689

/Janice A. Mooneyham/  
Supervisory Patent Examiner, Art Unit 3689



